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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,689	08/02/2001	Tanja Reuter	EL714747724US	6562

21559 7590 07/18/2003

CLARK & ELBING LLP  
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BOSTON, MA 02110

EXAMINER

ALLEN, MARIANNE P

ART UNIT PAPER NUMBER

1631

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/890,689

Examiner

Marianne P. Allen

Applicant(s)

REUTER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

This application was filed under 35 USC 371 and based on PCT/EP00/00506 in the German language. MPEP 1893.01 (d) discusses translations of international applications entering the national stage in the U.S.

#### **MPEP 1893.01(d) Translation**

Applicants entering the national stage in the U.S. are required to file a translation of the international application (if the international application was filed in another language). 35 U.S.C. 371(c)(2). A "Sequence Listing" need not be translated if the "Sequence Listing" complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b). See 37 CFR 1.495(c). The translation must be a translation of the international application as filed or with any changes which have been properly accepted under PCT Rule 26 or any rectifications which have been properly accepted under PCT Rule 91. Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation. If an amendment to the international application as filed is desired for the national stage, it may be submitted in accordance with 37 CFR 1.121.

Applicant's translation which forms the instant specification does not appear to be a translation of the international application as filed. It appears to include Article 34 amendments to the claims, including amendments to claims 1, 7, 18, 20, and 22. It is noted that claims 18, 20, and 22 were found to be inadmissible in the IPER (see Form PCT/IPEA/409).

Clarification is requested.

Applicant is reminded that the claims should recite the appropriate SEQ ID NOS.

It is noted that the disclosure contains embedded hyperlinks and/or other forms of browser-executable code. Applicant is required to delete the embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01.

It is noted that the abstract following the claims is titled as a summary. In addition, it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6 and 12 drawn to nucleic acids.

Group II, claim(s) 7, drawn to transgenic animals.

Group III, claim(s) 8-10, drawn to polypeptides.

Group IV, claim(s) 13-14, drawn to antibodies.

Group V, claim(s) 15, drawn to a method for the identification of effectors.

Group VI, claim(s) 16, drawn to a pharmaceutical composition containing multiple components.

Group VII, claim(s) 17-18 and 23, drawn to a method of diagnosing a disease.

Group VIII, claim(s) 19-22 and 24, drawn to a method of treating a disease.

Should applicant elect any of Groups VI-VIII, applicant must further elect a particular pharmaceutical composition set forth in claim 16 or 18. Note that each of the listed components differs structurally and functionally. Examination will be limited to the particular pharmaceutical composition elected.

Applicant is advised that claims 12 and 16-24 are improperly multiply dependent.

Applicant is advised that claim 15 and 17-18 contain no method steps.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of Group I is the structure of the claimed nucleic acid. As prior art can be applied against the invention of Group I no special technical feature exists linking the inventions. Note that a special technical feature must distinguish over the prior art. Note that Form PTO/IPEA/409 indicates a lack of novelty for claims 1-3. In addition, as the claims fail to indicate that nucleic acid is isolated art disclosing the chromosome would anticipate the claims. In addition, as the claims encompass fragments of unspecified length, art disclosing "ATG" encoding methionine (for example) would anticipate the claims.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 8:30 am - 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*Marianne P. Allen*  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631

mpa  
July 17, 2003